

REMARKS

Claims 1-37 are pending in the application.

Claims 1-37 have been rejected.

Claims 1, 12-14, 24 and 34 have been amended.

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Rejection of Claims Under 35 U.S.C. §103

Claims 1-10, 12, 14-21, 24-32, 34, and 36-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,361,359 issued to Tajalli et al. ("Tajalli") in view of U.S. Patent 5,812,981 issued to Noguchi ("Noguchi"). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation

of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 1, 14 and 24, as amended, each contain limitations of substantially the following form or content:

an application program comprising
 one or more business components,
 means for selecting a business component to be audited from the one
 or more business components,
 means for selecting one or more selected operations on the business
 component to be audited, and
 means for creating an audit trail for the application program, wherein
 a business component comprises one of a table or record
 comprising information associated with an entity.

See, e.g., Claim 1 (as amended). Applicants respectfully submit that neither Tajalli nor Noguchi, alone or in combination, provide disclosure of each of these claim limitations.

Neither reference cited by the Office Action provides disclosure to the claimed “business components.” The amended claims provide that “a business component comprises one of a table or record comprising information associated with an entity.” Support for this amended claim language can be found at least on page 9 of the Application.

The Office Action cites to the following text as support for an “application program comprising one or more components” in Tajalli:

The operating system 215 manages all physical resources, including all components inside the system cabinet 120 and, via the interface ports 114, all components outside the system cabinet 120.

Office Action, p.3 (citing Tajalli 10:30-34). The Office Action equates Tajalli’s operating system 215 with the application program and equates the various physical components of Tajalli’s disclosed “high integrity” (HI) system illustrated in Figure 1 with

the claimed “business components.” *See* Office Action, p.3; *see also* Tajalli 9:19-23 (“The HI system 100 includes a system cabinet 120 which encloses a memory 110, a central processing unit (CPU) 112, a number of interface ports 114, a protected media (PM) 118, and a user media (UM) 119.”). Applicants submit that Tajalli itself establishes that the disclosed “operating system 215” does not itself comprise all the physical components of the illustrated HI system 100, as is required by the claims. Instead, the operating system is said to “manage” the physical resources. Thus, those components cannot be equated with the claimed “business components.” Further, none of Tajalli’s “physical resources” are a table or record comprising information associated with an entity.

In an attempt to overcome this deficiency of Tajalli, the Office Action resorts to referencing a section of Noguchi as providing disclosure of “business components.” *See* Office Action, p. 3 (admitting that Tajalli does not explicitly disclose business components). The cited section of Noguchi provides disclosure of a purported “business application 101 ... configured of business software (a program for business processing) 102 and a database 103.” Noguchi 4:26-28. Again, this disclosure does not provide the claimed “one of a table or record comprising information associated with an entity.” Further, the Office Action provides no support for how Noguchi’s “business applications” are substitutable for Tajalli’s physical components, and, in fact, it would make no sense to substitute Tajalli’s physical (hardware) components with the software of Noguchi.

In addition, the Office Action appears to be merging the two distinct embodiments provided by Tajalli. Tajalli Figure 2 is said to illustrate a “protected media” (PM) of the disclosed high integrity (HI) system embodiment. *See* Tajalli 10:27-

28. Tajalli provides no disclosure of the HI system using auditing to purportedly provide the disclosed system protection. *See, e.g.*, Tajalli 6:27-41 (“The operating system, the approved applications and the approved data are stored on a protected media (PM) to which the ordinary user and application programs cannot write.”); Tajalli 6:54-62 (“The HI system assures the integrity of the operating system, the approved applications and the approved data while still enabling the ordinary user to create and execute application programs and to modify application programs and data which are not on the protected media. The HI system can therefore be used to protect certain critical applications and data without compromising system flexibility for non-critical applications and data.”). Tajalli also provides a distinct second embodiment, called the “Assured Audit” (AA) system, which “employs a slightly different PM 118 and has auditing capabilities.” Tajalli 15:2-3. These purported auditing features purportedly “enables the administrator to accurately monitor system uses, to the extent he desires. The AA system provides a high level of flexibility, as it permits ordinary users to create, modify and execute application programs which do not interfere with the auditing.” Tajalli 7:9-15. The distinction between these two embodiments is made clear in Tajalli by the completely separate disclosure provided in the specification of that patent. *Compare* Tajalli 8:49-14:65 (High Integrity system disclosure) *with* Tajalli 14:66-17:27 (Assured Audit system disclosure).

In response to the previous Office Action in this matter, which is incorporated herein by reference, Applicants have already established that Tajalli’s Assured Audit system cannot provide support for the limitations of the independent claims. *See, e.g.*, Preliminary Amendment, pp. 11-13 (accompanying Request for Continued Examination dated June 19, 2006). As discussed more fully below, Applicants respectfully submit that

it is improper to combine elements of two distinct embodiments provided by Tajalli in an attempt to remedy the deficiencies provided by either embodiment. Tajalli provides no motivation for combining those distinct embodiments and, in fact, teaches away from such a combination by distinctly describing the embodiments themselves. Further, combining the security features of the HI system with the AA system is redundant at best and there is no indication that such a combination would be successful or desirable.

The Office Action provides no citation to either Tajalli nor Noguchi for the “means for selecting a component to be audited” limitation. *See* Office Action, p.3. Instead, the Office Action suggests that this disclosure is “implicit: if the component comprises an operation and an operation is audited, then the component has to also be audited.” *Id.* In order for a proposition to follow implicitly from a disclosure, that proposition must necessarily follow from the disclosure. The Office Action provides no discussion of why the cited illustrated HI system must provide the claimed “means for selecting a component to be audited.” Applicants respectfully submit that it makes no sense to provide auditing of Tajalli’s physical components. Further, Tajalli makes no reference to auditing the physical components of the system through the use of the referenced “assured audit” (AA) system, which, as discussed above, is distinct from the HI system cited by the Office Action. *See also* Tajalli 6:63-65 (AA system purportedly “collects audit information about the activities of ordinary users and application programs.”). Finally, even were the statement regarding the implicit nature of the disclosure to be true, a proposition with which Applicants do not agree, there is still no disclosure of the claimed “means for selecting a component to be audited” nor does the Office Action provide any argument or discussion that such disclosure is provided.

For at least the above reasons, Applicants respectfully submit the Office Action does not establish the presence of the above-discussed limitations in either Tajalli nor Noguchi, alone or in combination.

The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.02(j). For the reasons presented above, neither Tajalli nor Noguchi, alone or in combination, teach these limitations of Claim 1. Independent Claims 14 and 24 include limitations of substantially the same scope as those of independent Claim 1 discussed above. Therefore, for at least the reasons discussed above, Applicants respectfully submit that neither Tajalli nor Noguchi, alone or in combination, teach these limitations of independent Claims 14 and 24.

Applicants also respectfully submit that the Office Action does not satisfy the burden of factually supporting the alleged motivation to combine the two references. This duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required.

Applicants have discussed above the lack of motivation to combine elements of the distinct embodiments provided by Tajalli. As stated above, there is no indication within Tajalli itself that such a combination would be desired or successful. Further, such a combination would be at best redundant.

The Office Action states that Noguchi should be combined with Tajalli because Tajalli may be employed in a business context and therefore any components within Tajalli would be “business components.” But such a rationale ignores the subject matter content of Noguchi and Tajalli. As discussed above, Tajalli purports to relate to, at least in one cited embodiment, an assured audit system that provides security protection for a computing environment “by providing restrictions which cannot be changed by any application or ordinary user.” *See, e.g.*, Tajalli 6:1-2. Noguchi, on the other hand, relates to providing “a method of creating an object oriented system which is arranged to easily create a system for doing general processes concerning data items, in addition to a data item treated by each GUI part on a screen.” *See, e.g.*, Noguchi 1:58-62. While mention is made of “a business application” which is configured of business software (Noguchi 4:27-28), there is no connection made within the cited section of Noguchi to either an auditing system or a security system as purportedly disclosed in Tajalli. Thus, Applicants respectfully submit that there is no reason within the references to combine Tajalli with the business software disclosed in Noguchi.

Applicants respectfully submit that therefore the argument raised in the Final Office Action fails to establish a *prima facie* case of obviousness and runs perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine Tajalli with Noguchi from within the references themselves, or for combining elements of the distinct embodiments of Tajalli with one another; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *See Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000).

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Indeed, Tajalli is in the separate and distinct field of restricting access to application programs (Tajalli 1:18-20), rather than the field of processing data items in a business application program (Noguchi 1:10-13). Nor does the Office Action present any evidence of a problem to be solved from within those references themselves.¹ Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicants’ own disclosure.

Using Applicants’ own disclosure as a blueprint for providing the motivation to combine prior art references in an obviousness determination is impermissible. *See W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”).

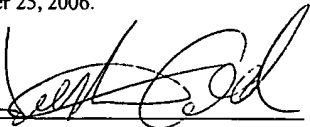
¹ There must be a finding that “there was a disadvantage to the prior systems, such that the ‘nature of the problem’ will have motivated a person of ordinary skill to combine the prior art references.” *Ruiz*, 234 F.3d at 666.

For at least the above reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of independent Claims 1, 14 and 24, and all claims dependent therefrom, and that they are in condition for allowance. Applicants therefore request the Examiner's reconsideration of the rejections to those claims and an indication of the allowability of same.


CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

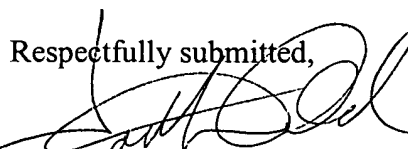
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on October 25, 2006.



Attorney for Applicant(s)


10/25/2006
Date of Signature

Respectfully submitted,


Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]